

THE OFFICE ACTION

In the Office Action mailed March 22, 2006, claims 1-4, 6, 7, 9, 10 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,130,174 issued to Hawley et al. (Hawley) in view of U.S. Application No. 2005/0112314 filed by Hamilton et al. (Hamilton).

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hawley and Hamilton as applied to claim 1, and further in view of U.S. Patent No. 5,874,371 issued to Owen.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hawley and Hamilton as applied to claim 1, and further in view of U.S. Application No. 2003/0036323 filed by Aliabadi.

Claims 11-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hawley in view of Hamilton, and U.S. Application No. 2002/0094404 filed by Schottenfeld.

REMARKS

Claims are Patentable over Hawley in View of Hamilton

With reference to the rejection of claims 1-4, 6, 7, 9, 10 and 15, in the Response to Arguments section of the Office Action mailed March 22, 2006, the Examiner states that Applicant's argument that the adherent sheet material disclosed by Hamilton is not repositionable in the same sense as the embossed film of the present application is not persuasive. In particular, the Examiner asserts that the argument is not commensurate in scope with the claims because the claims do not require that the film be repositionable. Applicant respectfully disagrees for the reason that independent claim 1 recites a "removable non-slip, non-adhesive covering" which "resists slipping laterally" which would implicitly make the covering repositionable. However, in order to eliminate any confusion as to the scope of the claims, claim 1 has been amended herein to clearly recite a limitation that the non-adhesive covering "remains indefinitely repositionable."

Applicant notes in regard to the film being repositionable as described above, that Hamilton only teaches a sheet that is temporarily repositionable and is not repositionable after final application. For example, in paragraph 38, Hamilton teaches that "the sheet 10 can demonstrate a releasable bond, i.e., a temporary

bond, be either removed without destroying sheet material 10 or repositioned and then activated completely once placed in desired position upon target surface to form a permanent bond between sheet 10 and target surface.” Of particular relevance is that Hamilton describes the bond as “permanent” after complete activation. Claim 1, as amended, recites to the contrary that the covering remains indefinitely repositionable. Hamilton also discloses in paragraph 61 that the “temporary adhesive state allows the user to evaluate the position of sheet material 10 upon target surface 50 for only a very short time period; and if it is not in a desired position, remove sheet material from target surface and reposition it upon the target surface 50. When the user has found the final position of the wallpaper, a compressive force is applied to entire substrate 40 substantially perpendicular to a plane of sheet 10, thus deforming film protrusions 26. This exposes the adhesive 12 to the target surface 50 and thus preferably provides a permanent adherence for sheet material 10.” Hamilton neither teaches nor suggests that the wallpaper is repositionable after force is applied to the substrate in the final position, but instead describes the adherence as permanent.

Further with reference to claim 1, the Examiner asserts that Applicant's claims fail to set forth a specific reason for embossing. Although Applicant respectfully disagrees with the Examiner, claim 1 has been further amended herein to more clearly recite the reason for embossing the vinyl film as being “to provide a textured finish resembling one of a leather-like texture and a linen-like texture.” Similar language can be found in the claim as originally filed, however, the claim has been amended to more clearly associate the texture with the embossing. As described in more detail in a previous response (Amendment A), Hamilton seems to only teach or disclose embossing of the flexible film sheet (20) for the purpose of producing non-adhesive protrusions (26). Further, there is no motivation to combine Hamilton with Hawley since Hamilton does not teach embossing the substrate (40) which corresponds more appropriately to the embossed vinyl film of the present application.

Additionally, Hawley does not teach or suggest an embossed top surface or covering as recited in independent claim 1, but to the contrary, teaches away from an embossed surface by describing only a smooth top layer in col. 3, lines 5-12, and by including a limitation for a generally flat vinyl plastic sheet in each of independent claims 1 and 5. Therefore, the combination of Hamilton with Hawley would not

produce an embossed vinyl film having a textured surface as in the present application and recited in the claims.

Applicants respectfully submit that the aforementioned amendments to independent claim 1 are solely for the purpose of clarifying the originally intended scope of the claim, and no new matter has been added.

Independent claim 15 is a method claim incorporating the covering as defined in claim 1 and, therefore, all of the above arguments with reference to claim 1 apply as well to claim 15. Claim 15 has not been otherwise amended.

For the above-described reasons, Applicant submits that independent claims 1 and 15 are patentably distinct over the references and, therefore, are in condition for allowance, as are claims 2-10 depending from claim 1.

Claims are Patentable over Hawley in View of Hamilton and Owen

With reference to claim 5, the Office Action asserts that Hawley and Hamilton disclose the claimed invention except for the teachings that the scrim is a non-woven scrim. However, for the reasons set forth with respect to independent claim 1, from which claim 5 depends, Applicant respectfully submits that dependent claim 5 is in condition for allowance.

Claims are Patentable over Hawley in View of Hamilton and Aliabadi

With reference to claim 8, the Office Action asserts that Hawley and Hamilton disclose the claimed invention except for the teachings that the scrim is a polyester scrim. The Office Action further states that Aliabadi discloses a layer of polyester mesh fabric between layers of polyvinyl chloride. It should be noted that, although Aliabadi describes the polyester mesh fabric as being between layers of polyvinyl chloride in paragraph 23, Aliabadi's polyester mesh fabric is unlike the woven polyester scrim of the present application which is coated with a non-slip polyvinyl chloride resin as recited in dependent claim 8, rather than being placed between layers of polyvinyl chloride. However, for the reasons set forth with respect to independent claim 1, from which claim 8 depends, Applicant respectfully submits that dependent claim 8 is in condition for allowance.

Claims are Patentable over Hawley in View of Hamilton and Schottenfeld

With final reference now to independent claim 11 and claims 12-14 depending therefrom, the Examiner asserts in the Response to Arguments that Applicant's claims fail to set forth a specific reason for embossing. Although

Applicant respectfully disagrees with the Examiner, claim 11 has been amended herein to more clearly recite the reason for embossing the vinyl film as being "to provide a textured finish resembling one of a leather-like texture and a linen-like texture." Similar language can be found in the claim as originally filed, however, the claim has been amended to more clearly associate the texture with the embossing. As described in more detail in a previous response (Amendment A), Hamilton seems to only teach or disclose embossing of the flexible film sheet (20) for the purpose of producing non-adhesive protrusions (26). Further, there is no motivation to combine Hamilton with Hawley since Hamilton does not teach embossing the substrate (40) which corresponds more appropriately to the embossed vinyl film of the present application.

Additionally, Hawley does not teach or suggest an embossed top surface or covering as recited in independent claim 11, but to the contrary, teaches away from an embossed surface by describing only a smooth top layer in col. 3, lines 5-12, and by including a limitation for a generally flat vinyl plastic sheet in each of independent claims 1 and 5. Therefore, the combination of the release layer of Schottenfeld with the combination of Hamilton and Hawley would not produce an embossed vinyl film having a textured surface as in the present application and recited in the claims.

Applicants respectfully submit that the aforementioned amendment to independent claim 11 is solely for the purpose of clarifying the originally intended scope of the claim, and no new matter has been added.

For the above-described reasons, Applicant submits that independent claim 11 is patentably distinct over the references and, therefore, in condition for allowance, as are claims 12-14 depending therefrom.

Evidence of Commercial Success

Applicant also offers evidence of secondary considerations in this application. A declaration has been submitted under 37 CFR 1.132 which offers evidence of commercial success and long-felt need for embodiments of the instant application. This evidence is indicative of non-obviousness.

All requirements are met for a showing of commercial success. The declaration establishes a clear nexus between the claimed invention and the commercial success. This success is not the result of heavy advertising, but flows from the functions and advantages disclosed by the specification. See MPEP § 716.03.

All requirements are also met for a showing of long-felt need. The need has been recognized and acted upon in the marketplace, and it was not satisfied by another before the introduction by Applicant; see paragraphs 5-9. The invention satisfies the long-felt need. See MPEP § 716.04.

For the above reasons, Applicant requests withdrawal of the § 103(a) rejections.

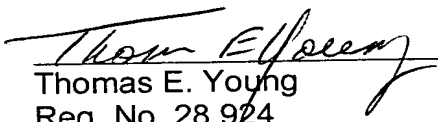
CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-15) are now in condition for allowance. Should the Examiner need more information or wish to discuss the present application, Applicant would appreciate the opportunity to assist in moving the case forward to a successful conclusion. In this regard, Thomas Young may be contacted at 216-861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

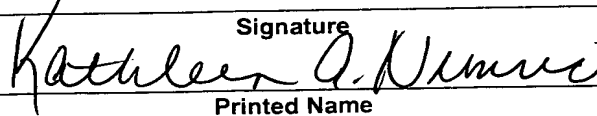
June 22, 2006
Date


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CERTIFICATE OF MAILING

Under 37 C.F.R. § 1.8, I certify that this Amendment is being

- ☒ deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- ☐ transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.
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Date June 22, 2006	Printed Name Kathleen A. Nimrichter

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